



# UNITED STATES PATENT AND TRADEMARK OFFICE

*Cen*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,459	02/04/2004	Hiroshi Takemoto	248348US-3 DIV	1340
22850 7590 12/12/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GOFF II, JOHN L	
			ART UNIT 1791	PAPER NUMBER
			NOTIFICATION DATE 12/12/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

## Office Action Summary

**Application No.**

10/770,459

**Applicant(s)**

TAKEMOTO ET AL.

**Examiner**

John L. Goff

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/237,661.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Priority***

3. In view of applicants amendment the disclosure of the prior-filed applications including Application No. 09/237,661 provides adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 1 and 2. Claims 1 and 2 have the benefit of priority to prior-filed applications including Application No. 09/237,661 which was filed 01/27/1999. The previous objections to the specification and oath are withdrawn in view of the amendment.

***Claim Rejections - 35 USC § 103***

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '784 (U.S. Patent 6,000,784) in view of Ito (JP 58049636 and see also the abstract).

The rejection is the same as that set forth in paragraph 7 of the Final Rejection mailed 9/20/07 not repeated here. Regarding claim 2, filtering the UV light as taught by Takemoto et al. '784 as modified by Ito is considered sufficient such that the intermediate member does not deform due to the UV light.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '015 (U.S. Patent 6,627,015) in view of Ito.

The rejection is the same as that set forth in paragraph 8 of the Final Rejection mailed 9/20/07 not repeated here.

6. In view of applicants priority date for claims 1 and 2 of 01/27/1999 and the submission of a correct statement of common ownership the previous rejections over Takemoto et al. (U.S. Patent 6,000,784) and Takemoto et al. (U.S. Patent 6,627,015) would be withdrawn. However, the statement of common ownership submitted 10/31/07 lists Application No. 10/770,457 which is not the correct Application No. of the instant application, i.e. 10/770,459. It is assumed this merely a typographical error. Applicants should submit a new statement of common ownership listing the instant application, i.e. Application No. 10/770,459, and the 35 USC 103 rejections will be withdrawn.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,224,709 in view of Arai et al. (U.S. Patent 5,361,168). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of U.S. Patent No. 6,224,709 fully encompass and disclose all the limitations of claims 1 and 2 of the instant Application except for that the intermediate moves due to contraction of at least one of the first adhesive and second adhesive due to curing. It is well taken in the art that a UV light curing adhesive generally contracts during curing as evidenced by Arai et al. (Column 10, lines 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the UV light curing adhesive taught by claims 1 and 2 of U.S. Patent No. 6,224,709 would contract during curing as was well taken to do so as evidenced by Arai et al. such that the intermediate moves

due to contraction of at least one of the first adhesive and second due to curing. It is noted that the instant application has the benefit of priority to prior-filed Application No. 09/777,847 and Application No. 09/237,661 now U.S. Patent No. 6,224,709. Further, Application No. 09/777,847 is a divisional of Application No. 09/237,661. However, claims 1 and 2 of the instant application were not present in the restricted claims of Application No. 09/237,661 and if the claims were present would have been drawn to the same elected invention such that the prohibition of a double patenting rejection does not apply (See MPEP 804.01).

9. The previous double patenting rejection over U.S. Patent No. 6,627,015 is withdrawn as the claims of U.S. Patent No. 6,627,015 do not describe curing the adhesive using UV light including filtering the light and also the intermediate member moving due to contraction of the UV curable adhesive during curing.

***Allowable Subject Matter***

10. Claims 1 and 2 would be allowed if the above rejections were overcome.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a method of adhering a first member to a second member via a first adhesive, an intermediate member, and a second adhesive as claimed including “curing said first adhesive and said second adhesive using UV light, wherein during the curing step, said intermediate member moves due to contraction of at least one of said first adhesive and said second adhesive due to curing, wherein said curing step includes filtering said light such that a color of said intermediate member is maintained” or “curing said first adhesive and said second adhesive using UV light, wherein during the curing step, said intermediate

member moves due to contraction of at least one of said first adhesive and said second adhesive due to curing, wherein said curing step includes filtering said light such that said intermediate member does not deform due to the UV light”.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff  
Primary Examiner  
Art Unit 1791